

REMARKS

Further and favorable reconsideration is respectfully requested in view of the foregoing amendments and following remarks.

Claim Amendments

Claim 8 has been amended to recite “consisting essentially of”, and to incorporate the limitations of claim 9. Claim 9 has accordingly been cancelled, without prejudice or disclaimer.

New claim 10 has been added to the application, based upon page 5, line 27, page 6, line 10, page 6, lines 21-22 and page 7, lines 1 and 2 of Applicants’ originally filed specification.

No new matter has been added to the application by these amendments.

Consideration After Final Rejection

Although this Amendment is presented after final rejection, the Examiner is respectfully requested to enter the amendments and consider the remarks, as they place the application in condition for allowance.

Patentability Arguments

The patentability of the present invention over the disclosure of the reference relied upon by the Examiner in rejecting the claims will be apparent upon consideration of the following remarks.

Rejection Under 35 U.S.C. § 103(a)

Claims 8 and 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Inoue et al. (WO 00/24273, with U.S. 2007/0212460 as the English translation). This rejection is respectfully traversed.

The Position of the Examiner

The Examiner takes the position that Inoue et al. teach Chinese medicine formulations including Kakkon-to and Sho-saiko-to as oral composition of jellies, made with hydrocolloids of locust bean gum, carrageenan and xanthan gum. The Examiner acknowledges that the reference does not teach the claimed concentrations. The Examiner also takes the position that the reference teaches that each of the claimed ingredients is suitable for combination in a pharmaceutical composition, and thus one of ordinary skill in the art would reasonably expect that the claimed ingredients could be combined together to produce a single pharmaceutical product.

Applicants' Arguments

As discussed above, claim 8 has been amended to employ the transitional phrase “consisting essentially of”. As indicated in MPEP § 2111.03, “the transitional phrase ‘consisting essentially of’ limits the scope of a claim to the specified materials or steps ‘and those that do not materially affect the basic and novel characteristic(s)’ of the claimed invention.” (Emphasis in original.)

Thus, Applicants’ amended claims exclude the presence of sucralose, which is prevalent throughout the teachings of the cited reference. [Applicants kindly request that the Examiner reconsider the arguments set forth in the response filed September 22, 2008, which discusses the teachings of Inoue et al. in detail.] In summary, the Inoue et al. reference relates to many possible uses of sucralose, as is evident by the first sentence of the Abstract of the reference, which recites “[n]ovel utilization of sucralose which is a high intense sweetener.” The Examiners acknowledged, during the August 13, 2008 telephonic interview with Applicants’ representative, that the Inoue et al. reference relates to uses for sucralose.

Thus, Applicants’ amended claim 8 (and new dependent claim 10) exclude the presence of sucralose in the composition. Specifically, the presence of sucralose in the cited reference is for the purpose of masking unpleasant taste. On the contrary, as indicated on page 1 of Applicants’ specification, “the present invention relates to a Chinese herbal medical composition in the form of a jelly, which hardly causes syneresis, is superior in the preservative stability, is broadly applicable to Chinese herbal medicine, and can be orally taken without taking care of the bitter taste, etc., of

the Chinese herbal medicine.” Thus, it is evident that the presence of sucralose would materially affect the basic and novel characteristics of Applicants’ claimed composition, since the presence of sucralose in the reference is for the purpose of taste masking. On the contrary, Applicants’ claimed composition does not require sucralose to achieve this effect.

Further, in response to the Examiner’s position that the unexpected results from [previously submitted] Experiments A, B and C are not commensurate in scope with the claims, Applicants note that claim 8 has been amended to incorporate the limitations of previous claim 9, and thus now includes ranges. The ranges present in amended claim 8 and new claim 10 are commensurate in scope with the previously provided experiments.

Additionally, Applicants remind the Examiners that during the telephonic interview of August 13, 2008, the Examiners indicated that amending the claims to recite “consisting essentially of” would likely overcome the obviousness rejection based on Inoue et al.

In view of the above remarks, as well as the remarks set forth in the response filed September 22, 2008, Applicants respectfully assert that claim 8, as well as dependent claim 10, are patentable over the cited reference. Accordingly, it is respectfully requested that the above-rejection be withdrawn.

Conclusion

Therefore, in view of the foregoing amendments and remarks, it is submitted that each of the grounds of rejection set forth by the Examiner has been overcome, and that the application is in condition for allowance. Such allowance is solicited.

If, after reviewing this Amendment, the Examiner feels there are any issues remaining which must be resolved before the application can be passed to issue, the Examiner is respectfully requested to contact the undersigned by telephone in order to resolve such issues.

Respectfully submitted,

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